

PATENT
Atty. Dkt. No. ROC920000310US1
MPS Ref. No.: IBM/2K/0310

REMARKS

This is intended as a full and complete response to the Final Office Action dated May 19, 2005, having a shortened statutory period for response set to expire on August 19, 2005. Applicant submits this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-34 are pending in the application. Claims 1-2, 4, 6-19, 21, and 23-34 remain pending following entry of this response. Claims 3, 5, 20, and 22 have been cancelled. Applicant submits that amendments to the claims do not introduce new matter.

Claim Rejections - 35 U.S.C. § 112

Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant submits, that the claims in their current amended form, particularly point out and distinctly claim the subject matter presented and respectfully requests withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3 and 5-6 are rejected under 35 US.C. 102(b) as being anticipated by *Aaker* (US. Pat. No. 5,758,087, hereinafter "*Aaker*").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim,... *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Aaker* does not disclose "each and every element as set forth" in the rejected claims. For example, *Aaker* does not disclose predicting, based on an initial received portion of a client command, the complete client command prior to receiving

Page 9

374347_1

PATENT
Atty. Dkt. No. ROC920000310US1
MPS Ref. No.: IBM/2K/0310

remaining portions of the client request, as claimed in independent claim 1. In contrast, *Aaker* discloses predicting a next command (request) after receiving an entire first request. *Aaker* does not disclose predicting a current request being received, prior to receiving the entire request, as claimed.

Accordingly, Applicant submits claim 1, as well as claims 2-3 and 5-6 that depend therefrom, are allowable, and respectfully request allowance of these claims.

Claim Rejections - 35 U.S.C. § 103

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker*. Claim 7 depends from claim 6, which is believed to be allowable for the reasons given above. Accordingly, Applicant submits claim 7 is also allowable and withdrawal of this rejection with respect to claim 7 is respectfully requested.

Claims 4, 8, 11-14, 16-25, 28-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* in view of *Luick* (US Patent 6,230,260).

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third element.

In this case, *Aaker* does not disclose predicting, based on an initial received portion of a client command, the complete client command prior to receiving remaining portions of the client request, as claimed in independent claims 1, 11, 18 and 28. In contrast, *Aaker* discloses predicting a next command (request) after receiving an entire first request. *Aaker* does not disclose predicting a current request being received, prior to receiving the entire request, as claimed. Accordingly, Applicant submits claims 1, 11, 18 and 28 and all claims that depend therefrom (directly or indirectly), are allowable, and respectfully request allowance of these claims.

PATENT
Atty. Dkt. No. ROC920000310US1
MPS Ref. No.: IBM2K0310

Claims 9-10, 15, 26-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* and *Luick* in view of *Yashiro et al.* (US Patent 5,787,460, hereinafter *Yashiro*). Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* in view of *Brye* (US Patent 6,718,322). Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aaker* and *Luick* in view of *Brye*.

These claims depend, directly or indirectly, from claims 1, 11, 18, and 28, which Applicant submits are allowable for reasons described above. Accordingly, Applicant submits these claims are also allowable and requests withdrawal of these rejections.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the office action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



Randol W. Read
Registration No. 43,876
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant

Page 11

374347_1